

REMARKS

The Applicant's counsel thanks the Examiner for the timely allowance of claims 36-42 and the indication of allowable subject matter in claims 21, 48, 54, and 64-65. Dependent claim 53 has been amended. Reconsideration of the present application, as amended, is respectfully requested.

As requested in the Office Action, submitted herewith is another copy of the IDS filed 5/17/01 (paper #4). We also note that the Examiner has asked for a copy of the corresponding PCT Application No. PCT/US99/16519. Copies of that application as originally filed and as published are enclosed herewith; however, unlike the case of a foreign priority claim under 35 U.S.C. §119, it is believed that such copies are not required to be submitted for a priority claim under 35 U.S.C. §120. Specifically, the §120 claim for the present application is made under U.S.C. §363, which states that an International Application designating the United States shall have the same effect as a national application except as otherwise provided in §102(e) -- domestic priority claims do not ordinarily entail submission of the prior application(s) to which priority is claimed. Correspondingly, it is believed that the Office Action Summary sheet may be incorrect in that box 13 is checked, which pertains to a §119 priority claim, instead box 15, which pertains to a §120 claim.

Claim 53 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite due to a lack of antecedent basis with respect to "said first circuit" terminology. Claim 53 has been amended to change "said first circuit" to --said circuit--. It is believed this change addresses concerns raised under §112.

Claims 1 and 7 were rejected under 35 U.S.C. §102(a) as being anticipated by U.S. Patent No. 5,815,090 to Su (the Su reference). The Applicants respectfully transverse. "[A]n invention is anticipated if the same device, including all the claim limitations, is shown in a single prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim." *Richardson v. Suzuki Motor Co. Ltd.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). As a result, a reference that coincidentally lists features of a claim without describing the claimed arrangement, relationship, or organization of such features cannot anticipate.

As an alternative to a preferred "wired" sensor type, the Su reference has only a single sentence of description for a "wireless" sensor type as follows: "[i]nstead of hard-wire components, such as cables, the system may instead be configured such that the sensors communicate with the data collection unit over independent wireless links formed using wireless communication devices, as shown for example in FIG. 3." (Su, col. 4, lines 20-25). This barest of descriptions and the simple schematic view of Su's figure 3 leaves much to the imagination regarding how it might be implemented or integrated into a system. The Su reference fails to specify the kind of wireless communication preferred, such as ultrasound, infrared (IR), radio frequency (RF), microwave, etc. Also, there is no disclosure regarding whether a wireless communication device would be included in a housing or given assembly, or whether it is integral to or can be separated from a sensor as described in connection with the wired version, to name but a few examples.

Among the undisclosed features of claim 1 are locating a pest control device after installation by receiving a wireless transmission from such a device. In contrast, the meager description of the Su reference fails to describe any detail about its manner of operation with a wireless link, communication/signal format, or the like; and certainly does not disclose the

ability to determine the physical location of a pest control device by receiving a transmission from a wireless communication circuit. Indeed, for this embodiment it appears Su's data collection unit just assumes the pest control stations are present. Device presence is not "locating" giving that term its ordinary meaning. In contrast, as described on page 11, lines 5-15, for example, interrogator 30 of the present invention may be used to scan or sweep a path along the ground to find each installed pest control device. The data collection unit of the Su reference is not described as being of a mobile type that one can use to discern between the locations of pest stations in this matter. In fact, one can speculate as to many ways that a wireless link communication can be implemented without locating. By way of nonlimiting example, a data control unit can simultaneously communicate with differently located pest stations in such a manner that signal differences relating to location are not provided or are ignored. Accordingly, it is respectfully submitted that the rejection claim 1 based on the Su reference should be withdrawn. Likewise, it is respectfully submitted the rejection of the corresponding dependent claim 7 should be withdrawn for at least the same reasons.

Dependent claim 68 was rejected as being unpatentable over the Su reference. This rejection is also traversed. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." Manual of Patent Examining Procedure (MPEP) §2142 (*citing In re*

Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). Moreover, a "prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." MPEP §2141.02.

A primary goal of the Su invention is directed to monitoring for the presence of termites before any pesticide is applied, as described, for example, in column 2, lines 15-30 of the Su reference. Communication between the stations and data collection unit occurs during the monitoring phase to indicate if termites have been detected. In conflict with Su, the features of dependent claim 68 include installation of the pest control device with a bait including a pesticide and communication circuit. In other words, pesticide is applied with the monitoring communication circuit which defeats Su's desire to apply pesticide after termite presence is detected. Accordingly, the Su reference actually leads away from the invention defined by claim 68. Thus, in addition to the patentability of the base claim, such further reasons support patentability of claim 68.

Claims 2-6, 8-16, 23-30, 32-35, 43-45, 47, 49, 56-63, 66-67, 69-76, 78, and 80-81 were rejected under 35 U.S.C. §103(a) as being unpatentable over the Su reference in view of U.S. Patent Number 5,764,138 to Lowe (the Lowe reference) and U.S. Patent Number 3,836,842 to Zimmermann (the Zimmerman reference). The Applicants respectfully traverse. To the extent this rejection asserts disclosure of "locating" in the same manner as in the §102 rejection, it is submitted that the same reasons make the rejection improper under §103.

Notably, the Office Action does appear to turn to the Lowe reference for such features, stating in relevant part: "wherein since the interrogation range is limited, detection of the transponder inherently locates the transponder to be in the proximity of the interrogator within a range defined by the effective communication range of the interrogator and transponder . . ." This statement is contrary to the pertinent law regarding inherency. Specifically, for an element to be inherently disclosed, it must

“necessarily be present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (*citing Continental Can Co. v. Monsanto Co.*, 948 F2d 1264, 1268 (Fed. Cir. 1991)). Indeed, inherency “may not be established by probabilities or possibilities . . . The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” 49 USPQ2d at 1951.

Even if there is some type of limit on the range of the code reader 20 in the Lowe reference, it does not necessarily follow that Lowe's RF tag 11 will always be "located" giving that term its ordinary meaning. In fact, Lowe's disclosure leaves open the possibility that the operable range is large enough to facilitate communication without ever isolating or finding RF tag 11. In support of this likelihood, the description only provides details with respect to an application of tag 11 to a tire without any indication that locating the tag 11 itself is of concern -- only communicating with it. Indeed, one stated goal is to "use the RF identification tag in a remote or inaccessible position to determine the state of the variable . . ." in column 2, lines 41-43 of the Lowe reference.

Moreover, one skilled in the art would be discouraged from practicing the asserted Su/Lowe/Zimmerman combination. “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 23 USPQ2d, 1783-84 (Fed. Cir. 1992) (holding that a combination of references does not render a claim obvious due to a lack of suggestion or motivation to combine or modify). As a corollary, the patent office has recognized that “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MPEP §2143.01. MPEP §2143.01 also states that “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references

are not sufficient to render the claims *prima facie* obvious.” Also, the suggestion/motivation to combine or modify under §103 needs to be specific. Where a “statement is of a type that gives only general guidance and is not specific as to the particular form of the claimed invention and how to achieve it ... [s]uch a suggestion may make an approach 'obvious to try' but it does not make the invention obvious.” *Ex parte Obukowicz*, 27 USPQ2d 1063, 1065 (U.S. Pat. and Trademark Off. Bd. of Pat. App. & Interferences 1993) (*citations omitted*).

A central operating principle of the Su reference is to reduce, if not eliminate, on-site manual inspections, as explained in column 2, lines 15-30:

One preferred system is useful in the monitoring phase or step of a two-step process for controlling termites, wherein one step is monitoring and the second step is control. The system of the present invention may conveniently provide for efficient monitoring of a given site for pest and/or other target factors. The resulting reduced or eliminated need for on-site manual inspections may allow for more comprehensive monitoring. Zones having at least one sensor each are checked on demand or pursuant to a specified schedule. If desired, the system may be configured in a manner that allows the location of sensed termite activity to be associated with a particular sensor or group of sensors. Data relating to the status of the sensors may be forwarded or retrieve for storage, recordal, review and/or analysis at a remote location.

In the Su reference, a data collection unit gathers sensor data from distributed monitoring stations. The Su reference illustrates these units for both the wired and wireless embodiments.

In contrast, the Lowe reference appears to be directed to a mobile code reader 20 that does require on-site, manual operation. Also, after a careful review of the Lowe reference, there does not appear to be any disclosure of the ability to store information in code reader 20 from more than one tag at a time as provided by the data collection unit, let alone remotely communicate the information as disclosed in the Su reference. Why would one undermine the intended remote monitoring operation of the Su system by modifying it to include a manual code reader from the Lowe reference? It is

respectfully submitted that to do so would defeat the intended purpose and operating principles of Su. Accordingly, the requisite suggestion/motivation to combine is absent.

The addition of Zimmerman does not cure the deficiencies of the Su and Lowe references, and even further indicates the improper nature of the asserted combination. To begin, the operation of Zimmerman's device is founded on detection of a purely magnetic or inductive signal -- not an RF communication. For example, the Zimmerman reference states in columns 3 and 4 that this device includes:

an encapsulation containing a coil or wire, i.e. an inductor, wound about a magnetically soft core material with the ends of the coil termination at a capacitive element. The coil material is essential in providing a high magnetic field capture or concentration function in the marking device. . . . Thus the core material must be highly permeable and exhibit low loss characteristics. . . . Even a minor fracture in the core material shifts the resonant frequency of a marking device to such a degree as to render its use marginal or even unsatisfactory.

In contrast, the Lowe antennae do not even appear to have a core, and the Su references does not even clearly specify RF communication. On the one hand, borrowing the marking aspects of Zimmerman while ignoring aspects believed to be essential to such operation is contrary to considering the reference teachings as a whole. On the other hand, RF communication performance is likely jeopardized if a core of the type stated to be essential to Zimmerman's marking operation is employed. Indeed, the prospects for a successful outcome would be speculative at best -- failing to impart a reasonable expectation of success as required to sustain obviousness.

In addition to shortcomings of the asserted combination generally, many claim-specific aspects of the rejection deserve reconsideration. For example, in rejecting claim 2, it was stated in connection with the Su reference that it includes "a transmitter configured to transmit a unique identifier in response to an interrogation (col. 3, lines 45-64; col. 1, line 5 to col.2, line 39), wherein unique

identifiers for the sensors are inherent in order to distinguish the plurality of sensors . . ." (Office Action, p. 4, ¶ 3). There are a number of ways that Su's "wireless links" can operate that do not include the ability to transmit a unique identifier. For example, the data collection device could separately address each monitoring station so that no identifying information needs to be transmitted by the station at all. Alternatively, the monitoring stations need not be configured to respond to an interrogation signal at all. For example, the stations could be arranged to continuously transmit to the data collection unit. In view of such alternatives, the recited features do not necessarily flow from the Su reference. Thus, it is respectfully submitted that unique identifier transmission by the monitoring station and response to an interrogation signal are not inherent aspects of the Su reference.

In rejecting claim 6, it was stated that the combination makes obvious "transmitting information about the pest control device from the interrogator to a data collection device . . ." (Office Action, p. 6, item 5). To the contrary, those skilled in the art would be discouraged from including both an interrogator and a data collection unit in view of the teachings of Su and Lowe. These features are also included in claims 9, 28-30, 32-35, 45, and 59 that have been likewise rejected with the Su/Lowe/Zimmerman combination.

Among the features of claim 17 rejected under the Su/Lowe/Zimmerman combination are both a passive RF communication circuit and an active RF circuit. One nonlimiting embodiment is described with reference to figure 9 of the present application. The Office Action fails to provide any rationale as to why there would be a motivation to combine the references to include both these circuit types.

The rejection of claim 32 seems to be based on the supposition that termite baits "by happenstance" can include "magnetic material in it or mixed with it, such as a result of storing the bait on a storage area previously used for storing magnetic material so that magnetic/iron remnants are mixed with the later bait material, would still be accepted by termites as food and therefore can still be

used in a system such as taught by [the references]." (Office Action, pp. 7-8, item 15). This rejection is founded on speculation as to what might be. Accordingly, it does not comply to the proper standard for establishing obviousness. At best, it could be understood to refer to common knowledge in the art or personal knowledge. To the extent this is the situation, a supporting reference is requested in accordance with MPEP §2144.03.

The rejection of claim 47 is based on the rejection explanation for claims 33 and 43 and further in view of Cates or Galyon. There is no discussion of how Cates or Galyon are being applied. Accordingly, obviousness is not properly established.

The features of claims 69, 71, 74, and 80 include a pest control device installed with a bait member including a pesticide and a communication circuit or transponder. Such features are contrary to Su's preferred operation as explained in connection with claim 68.

Even assuming a proper *prima facie* case has been established, secondary considerations counsel against obviousness of certain claims. "Objective evidence or secondary considerations such as unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present." MPEP §2141. Such evidence may be found in the instant application as declared to be accurate by the inventors. For example, the long-felt, yet unmet need to locate pest control devices is indicated on page 1, lines 25-31 of the present application as originally filed, and the solution to this locating problem as one aspect of the present invention is describe on page 10, line 30 through page 11, line 15. Also, the focus of the Su reference on reduction or elimination of on-site activity teaches away from the approach of several claims. Accordingly, it is respectfully submitted that there are numerous reasons that the rejection of claims based on the Su/Lowe/Zimmerman combination should be withdrawn.

Claims 16-20 and 22 were rejected under 35 U.S.C. §103(a) as being unpatentable over the Su reference in view of the Lowe reference. This rejection is traversed. The combination of the Su and Lowe references is improper for the same reasons previously explained in connection with the Su/Lowe/Zimmerman combination. Also, the assertion that a discrete multi-bit code is "inherent in order to distinguish the plurality of pest control devices" is flawed. There are other ways a unique identification signal can be transmitted besides as a multi-bit code. Moreover, as more specifically explained in connection with the rejection of claim 2, neither the transmission of a unique identification signal nor responsiveness to an interrogation signal necessarily result from the teachings of Su -- there being many alternatives that defeat inherency.

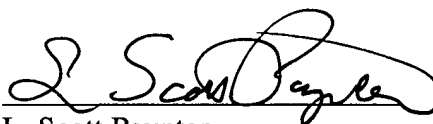
Dependent claims 31, 46, 77, and 79 were rejected under 35 U.S.C. §103(a) as being unpatentable over the Su reference in view of the Lowe and Zimmerman references and U.S. Patent Number 5,528,222 to Moskowitz (the Moskowitz reference). The Applicants traverse. These claims are patentable for at least the reasons that the respective base claims are patentable. Furthermore, to the extent this rejection is based on the assertion that the Su reference "uses passive transponders" (Office Action, p. 13, 2d ¶), it is flawed. Specifically, the Su reference lacks any explanation of how its wireless links operate. In fact, the only power source explicitly described is provided by wires in the main embodiment. From this description, one could alternatively conclude that the wireless links -- while wireless for communication purposes -- are powered by wired connections. Moreover, the Su reference lacks any indication of a transponder type of device, and could instead be of a continuously transmitting type. Also, the Moskowitz reference adds nothing to cure the defects in the Su/Lowe or Su/Lowe/Zimmerman combinations. Indeed, these references fail individually or collectively to teach or suggest the inclusion of both passive and active RF as provided among the unique features of claims 31, 46, and 79.

Claims 50-52 and 55 were rejected under 35 U.S.C. §103(a) as being unpatentable over the Su reference in view of the Lowe reference and U.S. Patent number 6,178,834 to Allen (the Allen reference). The rejection is traversed. The Allen reference adds nothing to cure the defects in the Su/Lowe combination, and likewise should be withdrawn.

Dependent claims 53 was rejected under 35 U.S.C. §103(a) as being unpatentable over the Su reference in view of the Lowe reference, the Allen reference, and the Moskowitz reference. The rejection is traversed. Claim 53 is patentable for at least the reasons given in connection with the corresponding base claim. Further, the asserted combination is improper as explained in connection with the Su/Lowe, Su/Lowe/Allen, and Su/Lowe/Zimmerman/Moskowitz combinations.

In view of the forgoing, it is believed that claims 1-81 are in condition for allowance. Reconsideration of the present application as amended is respectfully requested. The Examiner is encouraged to contact the undersigned by telephone to resolve any outstanding matters concerning the present application.

Respectfully submitted:

A handwritten signature in black ink, appearing to read "L. Scott Paynter", written over a horizontal line.

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